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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 053104

Application Number: 09/963,423
Filing Date: September 27, 2001
Appellant(s): JONDERKO ET AL.

Harris A. Pitlick
For Appellant

MAILED
JUN 03 2004
GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 19, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claim 25 does not stand or fall with claim 2 and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

5,508,370	Reiff et al.	4-1996
5,607,482	Reiff et al.	3-1997
5,693,737	Reiff et al.	12-1997
6,096,805	Lange et al.	8-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2-11, 13-21, 25, 27, and 28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the production of solid, pulverulent, water dispersible, blocked polyisocyanate adducts, wherein the percent contents of the reactants correspond to those disclosed (specification paragraphs 0007-0010 and 0031-0033), does not reasonably provide enablement for the production of solid, pulverulent, water dispersible, blocked polyisocyanate adducts utilizing any percent composition of reactants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Appellants have failed to provide adequate enablement for the production of viable solid, pulverulent, water dispersible, blocked polyisocyanate adducts utilizing percent compositions of reactants other than those disclosed. One of ordinary skill could not practice the invention as claimed without resorting to undue experimentation. Appellants have argued that Examples 1 and 2 and paragraphs 0020-0029 and 0036-0044 provide ample description of how to make the presently claimed invention. In response, the amounts recited within the examples correspond to the aforementioned disclosed percent contents and one of ordinary skill would consider the teachings

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of paragraphs 0020-0029 and 0036-0044 in view of the reactant percent contents recited within the aforementioned paragraphs, 0007-0010 and 0031-0033. Therefore, it is not seen that the specification provides the necessary guidance to permit one to produce the claimed blocked polyisocyanate adduct having the claimed properties under reaction conditions where the disclosed reactant percent contents are not utilized.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-11, 13-20, 25, 27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Reiff et al. ('370 or '482 or '737).

The references disclose the production of blocked isocyanates, wherein the blocked isocyanates are the reaction product of polyisocyanates, which meet applicants' claimed isocyanates; active hydrogen compounds containing ionic or potential ionic groups, which meet applicants' claimed ionic agents; polyols, which meet applicants' claimed polyols; blocking agents, which meet applicants' claimed blocking agents; and neutralizing agents, which meet applicants' claimed neutralizing agents. See abstract and columns 2-12 within Reiff et al.

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Appellants have argued that the references fail to disclose water dispersible, blocked polyisocyanate adducts in the form of solid, pulverulent material. The examiner has considered appellants' argument; however, given the extent to which the argued terms are defined, the position is taken that Reiff et al. disclose embodiments of the invention that satisfy the argued language. For example, Reiff et al. ('370 and '737) at column 11, line 25 and lines 50-55 and Reiff et al. ('482) at column 9, line 57 and column 10, lines 16-23 disclose that the blocked polyisocyanates may be produced as solids and that dispersions may be produced by mixing the blocked polyisocyanate with water, in the absence of solvents. Therefore, the position is taken that the references encompass the blocked polyisocyanate in solid form. Even in the form of a dispersion, the disclosed blocked polyisocyanate adducts are in the form of discreet particles. See column 12, line 10 within the ('737) reference, for example. Therefore, in the absence of further definition by appellants, the position is taken that the disclosed term, "particles", is clearly suggestive of that which is solid and pulverulent.

Appellants' argument with respect to the particle sizes of the blocked polyisocyanate has again been considered; however, the position taken within the Advisory Action of February 25, 2004 has been maintained. Firstly, the position is taken that the claimed lower endpoint of about 1 micrometer encompasses particle sizes below 1 micrometer (1,000 millimicrons). Secondly, the particles sizes of Reiff et al. are not confined to 50 to 500 millimicrons. It is noted that Reiff et al. ('482) recite a range endpoint of about 800 millimicrons (see column 10, line 51); this endpoint, in and of itself, is considered to be encompassed by appellants' claimed about 1 micrometer. Furthermore, the references do not require that the particles fall within the recited ranges; rather, the particle diameter is defined as the diameter at which 50% of the particles are

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above and 50% of the particles are below. In view of this definition, the position is taken that it is reasonable to conclude that approximately 50% of the particles of Reiff et al. (especially Reiff et al. ('482)) have a particle size that meets the claimed range endpoint of about 1 micrometer.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiff et al. ('370 or '482 or '737) further in view of Lange et al. ('805).

As aforementioned, the references disclose the production hydrophilic group containing, blocked polyisocyanates; however, the references are silent with respect to the addition of hydrophobic blocked polyisocyanates. Still, the position is taken that it would have been obvious to incorporate a quantity of hydrophobic, blocked isocyanates into the composition, because the addition of hydrophobic, blocked polyisocyanates to a hydrophilic, blocked polyisocyanate composition was known at the time of invention, as a means of easily incorporating the hydrophobic isocyanate into an aqueous polyurethane forming composition. See column 5 within Lange et al.

(11) Response to Argument

Appellants' arguments have been addressed within the *Grounds of Rejection*.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


RABON SERGENT
PRIMARY EXAMINER

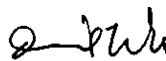
R. Sargent
June 1, 2004

Conferees:

Supervisory Patent Examiner James Seidleck



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